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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,435	07/26/2001	Elmootazbellah Nabil Elnozahy	AUS920010134US1	7373

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EXAMINER

HARRELL, ROBERT B

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,435

Applicant(s)

ELNOZAHY ET AL.

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/26/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/26/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: see attached Office Action.

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1. Claims 1-26 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. Figure 1 must be labeled "PRIOR ART" per page 2 (lines 10-26) and page 5 (line 14). Since the Specification and the Figures do not agree as to the status of Figure 1, both the Specification and the Figures are objected to for at least this reason.
4. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims. Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 21-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the claims are directed to Printed Matter. (In re Beauregard (CAFC) 35 USPQ2d 1383) and MPEP 2106). This rejection can be overcome by the addition of "embedded on a computer readable medium and read in by a computer," between "product" and "comprising" on line 1 of claim 21.

7. The following is a quotation of the second paragraph of 35 U.S.C 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-26 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The scope of meaning of the following claim language is not clear:

- a) "the storage request" -- claim 1 (lines 5 and 7), claim 2 (line 1),;
- b) "the requested information" -- claim 1 (line 8)[there is now two different types of requests, one on line 1 of claim 1 and line 5 of claim 5];

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- c) "the client-server connection" -- claim 2 (line 2);
- d) "the client-server connection information" -- claim 3 (lines 1-2);
- e) "the client-server protocol stack" -- claim 3 (line 1), similar in claim 6 (line 2);
- f) "the IP address" -- claim 4 (line 1);
- g) "the source address" -- claim 4 (line 2);
- h) "the requested data" -- claim 10 (lines 1-2), claim 11 (line 5);
- i) "the server's local cache"—claim 11 (lines 5, 6-7);
- j) exc...

9. As to 8 (a-j) above, these are but a few examples of numerous cases where clear antecedent bases are lacking and not an exhausting recital. Any other term(s) or phrase(s) over looked by examiner and not listed above which start with either "the" or "said" and do not have a single proper antecedent bases also is indefinite for the reasons outlined in this paragraph. Also, these are but a few examples where term(s) or phrase(s) are introduced more than once without adequate use of either "the" or "said" for the subsequent use of the term(s) or phrase(s). Moreover, multiple introductions of a term, or changes in tense, results in a lack of clear antecedent bases for term(s) or phrase(s) which relied upon the introduced term. Failure to correct all existing cases where clear antecedent bases are lacking can be viewed as non-responsive.

10. Per claim 1 (lines 7-8), such is not complete as no action in response to the storage request and generating a packet is recited in the claim. "responsive to the storage request, and generating a packet" then what happens?

11. The claims contain "means-plus-function language" (i.e., claim 21+). When such element(s) in a claim for a combination is expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, examiner must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof (see *In re. Donaldson Company, Inc.*, CAFC (2/14/94) 29 USPQ2d 1845). However, the corresponding structure, material, or acts described in the specification and equivalents thereof cannot be ascertained by examiner. Specifically each of the recited means for performing a function, as recited in the claims, cannot be matched with the corresponding structure, material, or acts in the specification. The applicant can resolve this issue by indicating "the" corresponding structure, material, or acts in the applicant's response by indicating the claimed "code means" each reside on a computer readable medium.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except

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that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

13. Claims 1, 2, 5-12, 15-22, 25, and 26 are rejected under 35 U.S.C. 102 (e) as being anticipated by DeSimone et al. (6,138,141).

14. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

15. Per claim 1, DeSimone taught a method of responding to a client request (e.g., see col. 1 (line 21 "client")) for information (e.g., see col. 1 (lines 25-31 "object")) from a service device (e.g., see col. 1 (line 24 "ISAP")) in a data processing network, comprising:

- a) receiving the information request from the client (e.g., see col. 1 (lines 42-45));
- b) responsive to determining that at least a portion of the requested information is not in a cache of the server device, sending the storage request to a network attached storage device (e.g., see col. 1 (lines 21-25));
- c) responsive to the storage request, generating a packet containing at least a portion of the requested information (e.g., see col. 1 (lines 21-25)) ; and
- d) sending the generated packet simultaneously to the client and to the server (e.g., see col. 1 (lines 37-41)).

16. Per above, in view of DeSimone, a method was known for an IASP to receive an information request from a client and responsive to determining that at least a portion of the requested information was not in a local cache of the IASP, the request was forwarded to a network attached storage device (Web Site with Web pages) who would generate a packet containing the requested information which was sent not only to the client but also to the IASP for storage in the IASP's local cache.

17. Per claim 2, such a method was over the Internet (col. 1 (line 24)) having TCP/IP.

18. Per claims 5 and 6, Internet addresses were unique, numeric identifier used, at the data link layer and other layers, to specify hosts and networks. Internet Protocol (IP) numbers were apart of a global, standardized scheme for identifying machines and networks that were connected to the Internet. Technically speaking, IP numbers were 32 bit addresses that consist of four octets, and they are expressed as four numbers between

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0 and 255, separated by periods, for example: 216.168.224.69 in which "216" was a multicast address for those machines within that octet range.

19. Per claims 7 and 8, the Internet was a Wide Area Network containing Gateways and Local Area Networks which packets traversed throughout.

20. Per claim 9, see col. 1 (lines 37-41).

21. Per claim 10, such is apart of TCP/IP (error correction).

22. Per claims 11, 12, 15-22, 25, and 26 these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above.


23. Claims 3, 4, 13, 14, 23, and 24 are allowable over the art of record since the art of record failed to teach, remotely suggest, or inherit generating a packet using the client-server connection information to replicate the client-server protocol stack in the generated packet.

24. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (571) 272-3896. The fax phone number for all papers is (703) 872-9306.

27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.


ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142